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10/9/03

To: Examiner Dung T. Nguyen
Group Art Unit 2871

From: David J. Torrente

Fax: 703 - 872-9318

Pages: 8 (including cover sheet)

Re: MICHIAKAI SAKAMOTO, et al.
U.S. Patent Applic No. 09/363,868
Filed July 29, 1999
Our Docket: 12873

Date: June 23, 2003

OFFICIAL

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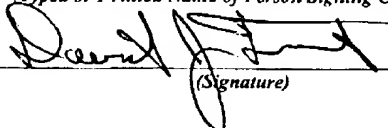
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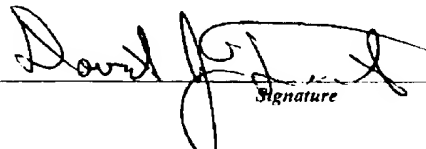
1. Certificate of Transmission by Facsimile (37 CFR 1.8)
2. Amendment Transmittal Letter (Large Entity) (in duplicate)
3. Response to Restriction Requirement (4 Pages)

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|--|-------------------------------------|-----------------------------------|-------------------------------|
| CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8) Applicant(s): MICHIKAI SAKAMOTO, et al. | | | Docket No. 12873 |
| Serial No. 09/363,868 | Filing Date July 29, 1999 | Examiner Dung T. Nguyen | Group Art Unit 2871 |
| Invention: LIQUID CRYSTAL DISPLAY DEVICE | | | |
| <p>I hereby certify that this <u>RESPONSE TO RESTRICTION REQUIREMENT</u> <i>(Identify type of correspondence)</i> is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703 872-9318</u>) on <u>October 9, 2003</u> <i>(Date)</i></p> <p style="text-align: center;"><u>David J. Torrente</u> <i>(Typed or Printed Name of Person Signing Certificate)</i>  <i>(Signature)</i></p> <p style="text-align: right;">RECEIVED FACSIMILE TRANSMISSION</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p> | | | |

P18/REV01

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|--|-------------------------------------|-----------------------------------|--------------------------------|----------------------------|-------------------|
| AMENDMENT TRANSMITTAL LETTER (Large Entity) | | | | Docket No. 12873 | |
| Applicant(s): MICHIKAI SAKAMOTO, et al. | | | | | |
| Serial No. 09/363,868 | Filing Date July 29, 1999 | Examiner Dung T. Nguyen | Group Art Unit 2871 | | |
| Invention: LIQUID CRYSTAL DISPLAY DEVICE | | | | | |
| <u>TO THE COMMISSIONER FOR PATENTS:</u> | | | | | |
| Transmitted herewith is an amendment in the above-identified application. The fee has been calculated and is transmitted as shown below. | | | | | |
| CLAIMS AS AMENDED | | | | | |
| | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST # PREV. PAID FOR | NUMBER EXTRA CLAIMS PRESENT | RATE | ADDITIONAL FEE |
| TOTAL CLAIMS | 22 - | 39 = | 0 x | \$18.00 | \$0.00 |
| INDEP. CLAIMS | 6 - | 6 = | 0 x | \$86.00 | \$0.00 |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/> | | | | | \$0.00 |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | \$0.00 |
| <div style="display: flex; justify-content: space-between;"><div><input checked="" type="checkbox"/> No additional fee is required for amendment. <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. <input checked="" type="checkbox"/> The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-1013 SSMP <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. <input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17.</div><div style="text-align: right;">Dated: October 9, 2003</div></div> <div style="margin-top: 20px;"> _____ Signature</div> <div style="margin-top: 10px;">David J. Torrente Registration No. 49,099 Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, New York 11530</div> | | | | | |
| <div style="display: flex; justify-content: space-between;"><div>CC:</div><div style="border: 1px solid black; padding: 5px; width: 80%;"><div style="text-align: center;">I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</div><div style="text-align: center; margin-top: 10px;">_____ Signature of Person Mailing Correspondence</div><div style="text-align: center; margin-top: 10px;">_____ Typed or Printed Name of Person Mailing Correspondence</div></div></div> | | | | | |

P11LARGE/REV08

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**Applicant(s):** MICHIAKI SAKAMOTO, et al.**Examiner:** Dung T. Nguyen**Serial No:** 09/363,868**Art Unit:** 2871**Filed:** July 29, 1999**Docket:** 12873**For:** LIQUID CRYSTAL DISPLAY DEVICE**Date:** October 9, 2003

Commissioner for Patents
P.O. Box 1450
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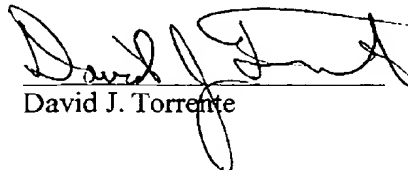
RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is responsive to the Office Action mailed 10 September 2003 in the above-captioned application. Pursuant to the Restriction Requirement imposed therein, Applicants provisionally elect **with traverse** the claims of Species A for continued prosecution herein. Claims 3-4 and 12-13, read on Species A, as it is defined. Claims 1 and 10, at least, are generic.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark office on the date shown below.

Dated: October 9, 2003
David J. Torrente

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Claims 1-22 are present in the above-captioned application. Applicant gratefully acknowledges the reconsideration and withdrawal of the restriction requirement made 21 May 2003. In the most recent Action, claims 1-22 are subjected to a new restriction requirement under 35 U.S.C. §121. Specifically, the Official Action avers that the following patently distinct species are present in the claims:

- A) A liquid crystal display (LCD) device in which a pixel electrode is formed over a common electrode (Fig. 1A, claims 3-4 and 12-13).
- B) An LCD having a common electrode forming [*sic*, formed] over a pixel electrode (Fig. 5B, claims 5 and 14).

It is the Examiner's position that the inventions listed as Species A and B are distinct from each other. Claims 1 and 10 are generic to both species.

In response to the Examiner's requirement for restriction, Applicants provisionally elect with traverse to prosecute the subject matter of Species A for continued prosecution herein. Claims 3-4 and 12-13 read on Species A, as it is defined. However, Applicants respectfully submit that in addition to claims 1 and 10, claims 2, 6-9, 11 and 15-22 are generic to both species. Applicants reserve the right under 35 U.S.C. § 121 to file one or more divisional applications directed to the non-elected claims in this application.

Pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

The revised restriction requirement does not address the propriety of the restriction at this late stage of prosecution, particularly where the defining characteristics of the Species were present in the original claims. Restriction is only proper where a search of the entire application present an undue burden on the Examiner. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." *See*, MPEP, 8th Ed., Rev. 1, § 803. In this case, the subject application, following a first Restriction Requirement, has already received two Office Actions on the merits. The prior art relevant to all disclosed subject matter should be developed at this point. *See*, MPEP, 8th Ed., Rev. 1, § 904.03. Therefore, Applicant respectfully submits that an action on all claims present presents no undue burden, and kindly requests that the Restriction Requirement be withdrawn.

Applicants respectfully traverse the indication that only claims 1 and 10 are generic. Claims 2, 6-9, 11 and 15-22 do not recite the position of the pixel electrode with respect to the common electrode. Therefore, these claims must be generic to both species. Applicant respectfully points out again that no claim recites either the pixel electrode or the common electrode "over" each other in any order. The claims merely recite the pixel and common electrodes separated by an interlayer separation film, and non-generic claims go on to recite the interlayer separation film formed on either a pixel or common electrode, and further the complimentary common or pixel electrode being formed on the interlayer separation film. Use of the term "over" can be taken to imply a more specific positional relationship that is not recited in the claims.

In view of the foregoing, an examination on the merits of the elected claims, at an early date, is earnestly solicited. However, it is respectfully urged that the Restriction Requirement is improper and poorly taken, and should therefore be reconsidered and withdrawn. An action on the merits with respect to all the claims is kindly solicited.

Respectfully submitted,



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